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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,296	10/17/2003	Jeffery R. Parker	GLOLP0108USI	9192
7590	12/14/2004		EXAMINER	
Donald L. Otto Renner, Otto, Boisselle & Sklar, LLP 19th Floor 1621 Euclid Avenue Cleveland, OH 44115-2191			SEMBER, THOMAS M	
			ART UNIT	PAPER NUMBER
			2875	
DATE MAILED: 12/14/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/688,296	Applicant(s) PARKER ET AL.	
	Examiner Thomas M Sember	Art Unit 2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>012904</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification does not provide support for having deformities on another side without ridges. The applicant is also reminded that this feature wasn't in the original specification of U.S. Patent 5,613,751 on which the applicant claims priority. Furthermore, the specification does not use the term "ridges" in the specification.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the panel having deformities on an opposite not having ridges must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering

of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3 and 5-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-97 of U.S. Patent No. 5,613,751 and claims 1-25 of U.S. Patent No. 6,755,547 and claims 1-31 of U.S. Patent No. 6,749,312. Although the conflicting claims are not identical, they are not patentably distinct from each other because the applicant merely uses slightly different wording to claim the same inventions as the claims of the U.S. Patents listed above.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-42 of U.S. Patent No. 6,712,481; claims 1-44 of U.S. Patent No. 6,752,505; claims 1-18 and claims 1-31 of U.S. Patent No. 6,755,547. Although the conflicting claims are not identical, they are not patentably distinct from each other because the applicant merely uses slightly different wording to claim the same inventions as the claims of the U.S. Patents listed above.

2. Claims 1-3 and 5-18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable claims 1-37 of copending application 10/729,113; and claims 1-34 of copending Application No. 10/784,527. Although the conflicting claims are not identical, they are not patentably distinct from each other because the applicant merely uses slightly different wording to

claim the same inventions as the claims of the U.S. applications listed above. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 1-18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of copending application No. 10/324,880; claims 1-16 of copending application 10/324,882; claims 1-27 of copending application 10/325,573 and claims 1-73 of copending Application No. 10/619,815. Although the conflicting claims are not identical, they are not patentably distinct from each other because the applicant merely uses slightly different wording to claim the same inventions as the claims of the U.S. applications listed above. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical

Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-3 and 5-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Parker et al (U.S. patent No. 6,752,505 (different inventive entity as pending application. Inventor McCollum is added and inventor Coghlan is deleted) (U.S. 6,079,838 (Kelsch added and Ezell deleted); U.S. application 10/784,527 (Parker only); Parker (U.S. Patent No. 6,755,547) and U.S. Patent No. 5,876,107 (Kelsch added and Ezell deleted). (U.S. 6,079,838 (Kelsch added and Ezell deleted); U.S. application 10/784,527 (Parker only) and Parker (U.S. Patent No. 6,755,547) and U.S. Patent No. 5,876,107 (Kelsch added and Ezell deleted) discloses an optical assembly comprising at least a light emitter, a pattern of individual deformities of well defined shape that are projections or depressions on or in at least one side of the light emitter for controlling an output ray angle distribution of light emitted from at least one surface area of the light emitter to suit a particular application, the deformities being quite small in relation to a width and length of the light emitter, at least some of the deformities having two or more surfaces that come together to form a ridge having a total length that is quite small in relation to the width and length of the light emitter, the ridge of at least some of the deformities having ends that intersect the light emitter or other deformities where the ridge ends, and additional deformities that are projections or depressions on or in an opposite side

of the light emitter. As broadly claimed, each of the ridges having a total length that is quite small in relation to the width and length of the light guide, the end points of at least some of the ridges intersecting the light guide or other deformities where the ridges end.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 5-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Parker et al (U.S. Patent No. 5,613,751). Parker et al (U.S. Patent No. 5,613,751) discloses an optical assembly comprising at least a light emitter, a pattern of individual deformities of well defined shape that are projections or depressions on or in at least one side of the light emitter for controlling an output ray angle distribution of light emitted from at least one surface area of the light emitter to suit a particular application, the deformities being quite small in relation to a width and length of the light emitter, at least some of the deformities having two or more surfaces that come together to form a ridge having a total length that is quite small in relation to the width and length of the light emitter, the ridge of at least some of the deformities having ends that intersect the light emitter or other deformities where the ridge ends, **and additional deformities (see column 5, lines 6-16) that are projections or depressions on or in an opposite side of the light emitter.** As broadly claimed, each of the ridges having a total length



that is quite small in relation to the width and length of the light guide, the end points of at least some of the ridges intersecting the light guide or other deformities where the ridges end.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Rudisill et al. Rudisill et al discloses an optical assembly comprising at least a light emitter, a pattern of individual deformities (48 and 50) of well defined shape that are projections or depressions on or in at least one side of the light emitter for controlling an output ray angle distribution of light emitted from at least one surface area of the light emitter to suit a particular application, the deformities (48 and 50) being quite small in relation to a width and length of the light emitter, at least some of the deformities having two or more surfaces that come together to form a ridge having a total length that is quite small in relation to the width and length of the light emitter, the ridge of at least some of the deformities having ends that intersect the light emitter or other deformities where the ridge ends, and additional deformities that are projections or depressions on or in an opposite side of the light emitter. The deformities can be conical (no ridges), triangular or random on either side.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas M Sember whose telephone number is 571-272-2381. The examiner can normally be reached on M-F 8 A.M- 5.30 p.m. first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on 703-305-4939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas M Sember  
Primary Examiner  
Art Unit 2875